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EXAMINER

DEPUMPO, D

ART UNIT

PAPER NUMBER

3611

DATE MAILED:

07/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/582,870

Applicant(s)

Sano

Examiner  
Daniel G. DePumpo

Art Unit  
3611



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 29, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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1. Applicant's election with traverse of species I (fig. 7, all claims allegedly readable thereon) in Paper No. 7 is acknowledged. The traversal is on the ground(s) that Rule 141 is not applicable to the present PCT application. This is not found persuasive because the restriction is not based on Rule 141. Instead, the restriction is based upon lack of unity under PCT Rule 13.1. See paragraph 1 of the restriction. Rule 141 merely provides that non elected claims may be rejoined upon allowance of a generic claim. If, for some reason, applicant does not desire the rejoinder of any non-elected claims, such claims will be canceled. PCT Rules 13.1 and 13.2 state that the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole makes over the prior art. In view of the rejections below, it is clear that none of the claimed inventions makes a contribution over the prior art. Since the claims do not make a contribution over the prior art, they do not contain a common special technical feature. Therefore, unity of invention is lacking.

The requirement is still deemed proper and is therefore made FINAL.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-28 are objected to under 37 CFR 1.75 as many of these claims are substantial duplicates of each other. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The following are some examples of claims that are identical or substantial duplicates: Claims 1 and 4, claims 5 and 8, claims 6 and 10, claims 7 and 11, claims 9 and 13, claims 6 and 25, claims 10 and 26. It is noted that this is not be a complete list because the number of claims is too numerous to specifically list all duplicates.

4. The disclosure is objected to because of the following informalities:

At page 9, line 1, it is unclear what is meant by the term "biting".

At page 10, line 3, it is stated that "applicant is developing a power steering apparatus ...". This implies that the device has not actually been developed and raises potential 35 U.S.C. 112 issues. Clarification and/or correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed above, many of the claims are identical or substantial duplicates of each other. Since the scope of many of these claims is the same, they are considered to be indefinite.

The claims are also replete with indefiniteness. Some examples of which are listed below.

In claim 1, line 8, "the peripheral direction" lacks antecedent basis. In lines 21 and 22, "the ones" and "the others" lack antecedent basis. Also in line 21 "closer" is vague and indefinite because this is a relative term.

In claim 2, line 3, it is unclear what element the term "each" refers to.

In claim 4, lines 7 and 8 recite the "corner portions are the ones ... second oil grooves".

This recitation is already in claim 3.

In claim 6, "low" and "high" are vague and indefinite because these are relative terms.

In claim 7, "as small as possible" is vague and indefinite.

These deficiencies occur throughout the claims and should be corrected accordingly.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's admitted prior art of figs. 1 or 2 (APA).

Figures 1 and 2 each show a steering apparatus and valve having the structure as claimed. The corners are chamfered at 6a and 6b.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuuichi (JP 08104246).

Yuuichi discloses a valve having the structure as claimed. The corners are chamfered at 55.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanazawa (JP 58188752) in view of Yuuichi.

Kanazawa discloses a steering apparatus substantially as claimed. The apparatus includes a motor wherein flow rate/pressure decreases when steering is not carried out. Kanazawa does not disclose the details of the control valve 13. Yuuichi, however, discloses a valve having the structure as claimed. It would have been obvious to use the valve of Yuuichi, since Kanazawa does not disclose the details of the control valve and since Yuuichi discloses that this valve is desirable to prevent an abnormal sound.

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12. Figures 1-6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

13. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

14. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kada et al., Inaguma et al., Haga et al., Strong, Suzuki et al., Behrens et al. '244, Behrens et al., '124 and Kobayashi disclose various devices having features in common with the instant invention.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. DePumpo whose telephone number is (703) 308-1113.

  
DANIEL G. DePUMPO  
PRIMARY EXAMINER

dgd

July 5, 2001